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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/799,378

Filing Date: March 12, 2004

Appellant(s): CHENEVICH ET AL.

Callie M. Bell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/20/2009 appealing from the Office action mailed 4/17/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0111946	Fallon	8-2002
7,146,367	Shutt	12-2006
6,859,212	Kumar et al	2-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fallon (U.S. Patent Application 2002/0111946) in view of Shutt (U.S. Patent 7,146,367) and further in view of Kumar et al ('Kumar' hereafter) (U.S. Patent 6,859,212).

With respect to claim 1, Fallon teaches A method of storing, storing, and organizing financial information electronically, the method comprising:

establishing a communication session (0165, 0172) between a first system (16) and a second system (10);

communicating information (0031; e.g. "The user can change, augment, or update the personal legacy plan at any time simply by accessing the Web site, entering identifying information, and accessing the stored information) associated with a financial document (0033, 0081, and 0682) from the second system (10) to the first system (16) the financial document (0033, 0081, and 0682) associated with a first account (Figures 3-1 and 8-2);

providing an online environment (0028, 0031) by the second system (16) configured to allow a customer user (0028; i.e. the term “user”) at the first system (16) to create a folder¹ in the online environment (0028, 0031) hosted at the second system (16) the folder being one of a plurality of folders (fig. 3-1; e.g. ‘Personal’, ‘Legal’, ‘Medical’, and ‘Financial’ folders) associated with the first account (Figures 3-1 and 8-2); and

to automatically and without human intervention (0013) associate the financial document (0013, 0033; e.g. “however, only the user can move the information and/or documents into the user's storage space) with the created folder so that the financial document (0033, 0081, and 0682) is included in the created folder in the online environment (0028, 0031) hosted at the second system (16) wherein the online environment (0028, 0031) displays the financial document (0033, 0081, and 0682) in the created folder (figures 4-7; i.e. documents are shown in their corresponding folders).

Fallon does not appear to teach creating a folder in the online environment so that the financial document can be included and displayed in the created folder.

Shutt, however, teaches creating a folder (drawing reference 107) in an online environment (figure 13).

In the same field of endeavor, (i.e. financial folder management), it would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine the teachings of the cited references because Shutt would have given Fallon the ability for a user to create folders in which to place documents for the benefit of having a customizable folder tailored to a user. Ultimately, a user of Fallon would benefit from at least this teaching

¹ Creating a folder as taught by Shutt

when they are provided with more organizational approaches (need shown by Fallon, en of 0013) to organize a wider variety of information items (needed by Fallon, 0009).

Fallon and Shutt do not appear to expressly recite receiving user selected filing preferences and associating the financial document with the created folder based on the received user selected filing preferences.

Kumar, however, teaches receiving user selected filing preferences (col. 39 line 14-15) at the second system from the first system and associating the financial document with the created folder based on the received user selected filing preferences (col. 39 line 8-17 and figures 18-20) for automatically categorizing financial information (i.e. transactions).

In the same field of endeavor, (i.e. information organization), it would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine the teachings of the cited references because Kumar would have given Fallon and Shutt a way to allow a user to specify where certain data should automatically be categorized (i.e. placed in a folder) for the benefit reducing the amount of time and effort needed to complete information gathering and organizing (needed by Fallon, 0165).

With respect to claim 2, Fallon teaches the method of claim 1, wherein the financial document includes credit card payments, debit card transactions, imaged checks, electronic bill payments or account statements (claim 18, figure 6).

With respect to claim 3, Fallon teaches the method of claim 1, wherein associating the financial document with the created folder is performed based on instructions from the customer user when the financial document is viewed (0012).

With respect to claim 6, Fallon teaches the method of claim 5, wherein the pre-established criteria includes merchant categories (figure 6).

With respect to claim 7, Fallon teaches the method of claim 1, wherein the online environment is further configured to allow the customer user at the first system to retrieve documents based on a document storage time stamp, date last accessed, date posted, dollar amount, group, or category (figures 4-6).

With respect to claim 8, Fallon teaches the method of claim 1, further comprising communicating financial information from a third system to the first system corresponding to the first account, wherein the third system and the second system contain separate and distinct accounts associated with the customer user (0012).

With respect to claim 9, Fallon teaches the method of claim 1, further comprising providing each of the plurality of folders with a public or private indication, the folders indicated as public being accessible by persons having a shared key (public key – 0168) given them by the customer user (0032).

Claims 10-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fallon (U.S. Patent Application 2002/0111946 A1) in view of Kumar et al. ('Kumar' hereafter) (U.S. Patent 6,859,212).

With respect to claim 10, Fallon teaches A system for storing, creating, and organizing financial information associated electronically, the system comprising:

a host computer (12) coupled to a network (fig. 1) and running programmed instructions to provide an on-line environment (0028, 0031) for a customer user (0028; i.e. the term “user”) at a customer user computer (16) connectable to the network (fig. 1) to organize, send, search, create, and save financial information (0033, 0081, and 0682) using a hierarchy of folders (0169) defined by the customer user (0028 and 0033; i.e. the term “user”) in the online environment (0028, 0031) hosted at the host computer (12), wherein each folder in the hierarchy of folders (fig. 6) includes a financial document (0033, 0081, and 0682) that includes multiple indicators (0047), wherein the financial document (0033, 0081, and 0682) is automatically and without human intervention (0013) associated with a folder (0203) in the hierarchy of folders (0169), wherein the host computer (12) is configured to provide a search across folders (0183-0184).

Fallon does not appear to expressly teach [associating the financial document with a folder] based on customer user selected filing preferences received from the customer computer.

Kumar, however, teaches teach [associating the financial document with a folder] based on customer user selected filing preferences (col. 39 line 14-15) received from the customer computer (col. 39 line 8-17 and figures 18-20) for automatically categorizing financial information (i.e. transactions).

In the same field of endeavor, (i.e. information organization), it would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine the teachings of the cited references because Kumar would have given Fallon a way to allow a user to specify where certain data should categorized (i.e. placed in a folder) for the benefit reducing the amount of time and effort needed to complete information gathering and organizing (needed by Fallon, 0165).

With respect to claim 11, Fallon teaches the system of claim 10, wherein the financial document includes credit card payments, debit card transactions, imaged checks, electronic bill payments or account statements (claim 18, figure 6).

With respect to claim 12, Fallon teaches the system of claim 10, wherein the financial document is associated with a folder based on instructions from the customer user when the financial information is viewed (0012).

With respect to claim 14, Fallon teaches the system of claim 10, wherein the multiple indicators include document storage time stamp, date last accessed, date posted, dollar amount, group, or category (figures 4-6).

(10) Response to Argument

Appellant's arguments found in the Appeal Brief (herein "Brief"), pages 5-19 have been fully considered but found unpersuasive as indicated in the following:

Rejection of claims 1-3, and 6-9 under 35 U.S.C. 103(a) (p. 7 of the Brief)

Argument (1): Fallon fails to teach, suggest, or disclose "automatically and without human intervention associating the financial document with the created folder based on the received user selected filing preferences" as recited in Claim 1.

Appellant's first argument, found on page 10 of the Brief states that Fallon fails to teach, suggest, or disclose "automatically and without human intervention associating the financial document with the created folder based on the received user selected filing preferences". Examiner respectfully disagrees.

Specifically, Fallon was used to teach the above claimed limitation to automatically and without human intervention (0013) associate the financial document (0013, 0033; e.g. "however, only the user can move the information and/or documents into the user's storage space) with the created folder.

As provided in the Final Office Action, Examiner disagreed because Fallon does teach an automated method to associate information to folders (e.g. 0203; "the invention is able, for example, to recognize..." and 0013; "automatically integrated across folders..."). The Examiner also noted that Appellant's argument is further unpersuasive in that reciting automatic means to

replace a manual activity is not sufficient to distinguish over the prior art. MPEP 2144.04 and *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Thus, while the portion of Fallon cited does describe a user able to move documents into the user's storage space (i.e. associate documents to folders), Examiner maintains that automation of a manual activity is not sufficient to distinguish over prior art.

Nonetheless, Fallon has other portions which can be read favorably to teach this argued aspect. For example, Fallon teaches² “*the invention* is able, for example, to recognize when an item of information is entered under one folder heading is also relevant to the contents of one or more of the other folders”. Fallon goes on further to state that “*the software* of the invention integrates such information so that it is readily available across all folders...Thus any information that is initially entered under a particular category in one of the folders is available in an appropriate category in one or more of the other folders.”

Thus, in light of the above cited portions, Fallon teaches that their invention and, more specifically, *the software of the invention* (i.e. “without human intervention”) is able to associate documents to other folders by making those documents available in one or more of the other folders.

Further yet, the combination of Fallon with Kumar teaches the claimed “automatically and without human intervention associate the financial document with the created folder...” Specifically, Kumar teaches the automatic association (of documents) to created folders by disclosing “When new transactions occur, they are automatically categorized according to user

² Refer to Fallon, paragraph 0203.

preference" (Kumar, col. 39, line 13-15). Thus Kumar is seen to provide an automated way to associate information to categories (or, folders) that would have benefited Fallon by providing a more efficient filing method and further reducing the amount of time and effort to organize information.

Argument (2): Appellant disagree that Fallon, Shutt, or Kumar teaches “associating the financial document with the created folder based on the received user selected filing preferences” as recited in Claim 1.

Appellants then disagree on page 11 of the Brief that Fallon, Shutt, or Kumar teaches “associating the financial document with the created folder based on the received user selected filing preferences”. Examiner respectfully disagrees.

As seen in the rejection above, Kumar, however, teaches receiving user selected filing preferences (col. 39 line 14-15) at the second system from the first system and associating the financial document with the created folder based on the received user selected filing preferences (col. 39 line 8-17 and figures 18-20) for automatically categorizing financial information (i.e. transactions).

Examiner further maintains that Kumar explicitly teaches a user creating categories (which may be seen as folders) and a system that automatically organizes transactions (i.e. financial documents) in col. 39, lines 8-17. As such, Examiner submits that Kumar teaches automatically filing transactions into created categories (i.e. folders) according to user preference.

Further, on page 11 of the Brief, Appellant traverses the cited portion of col. 39 lines 8-17 in Kumar. Examiner respectfully submits that Appellant incorrectly characterizes the Kumar reference by stating in light of Kumar's Column 39, lines 8-17, "[Thus,] Kumar describes sorting transactions based on default categories" (page 11, last paragraph). On the contrary, Kumar recites (in col. 39 line 13-15) "When new transactions occur, they are automatically categorized according to user preference." Thus, rather than "sorting based on categories" which is not even mentioned in the paragraph as incorrectly alleged by Appellant, Kumar categorizes according to user preference. Thus, categorizing (transactions) according to user preference is equivalent to the claimed associate the financial document with the created folder based on the received user selected filing preferences.

Appellant further provides a screenshot of Kumar's figure 21 and a paragraph relating to figure 18 (Brief, page 12) and then states "Sorting and displaying a transaction in a transaction history based on a category code is clearly distinct from "associating the financial document with the created folder based on the received user selected filing preferences..." Examiner respectfully disagrees and maintains that Kumar teaches automatically filing according to user preferences (see above paragraph), which is required by the claim. Examiner further submits that sorting and displaying based on categories is a process that occurs after the transactions are filed into categories. In other words, according to Kumar, when new transactions occur, they are automatically categorized according to user preference (col. 39 lines 10-17). Thus, the transactions are first [automatically] associated with a category in order to be effectively sorted and displayed. Further, Examiner submits that selecting a view in Kumar's system (e.g. fig. 21 drawing reference 329) describes transactions in a folder. That is, for example, a user selecting a

view based on "Entertainment" would be presented with a display according to the format dictated by the option selected (see Kumar, col. 40, lines 20-36). Thus, in this example, the "Entertainment" category serves as a folder for Entertainment transactions. Lastly, Examiner submits that one of ordinary skill in the art would recognize a category as a folder in that both effectively contain a group of files bearing a relationship. However, even if it can be persuasively argued that a category cannot be a folder, Examiner submits that the Shutt reference discloses this feature (e.g. Final Office Action, page 4).

On page 13, Appellant asserts that i) a transaction is not a document, and ii) a category is not a folder. Examiner respectfully disagrees given the following:

i) Examiner submits that a transaction can be seen as the claimed "financial document". Specifically, a transaction in view of Kumar is seen as a history of financial interaction with a banking system (e.g. see Kumar, abstract). In other words, Kumar's transaction is a record of interaction with a bank and thus a *document*. Thus, Appellant's assertion that "a transaction may be the amount and date of a check, but the transaction is not a document containing a copy of the check itself" may still readily be seen as a *record* (thus document) of the processing of the check.

Nonetheless, given the broadest reasonable interpretation, a "document" can generally be defined as a) a computer data file³, b) Something, such as a recording or a photograph, that can be used to furnish evidence or information, or c) A computer file that is not an executable file and contains data for use by applications⁴.

³ See definition of "document" according to Dictionary.com Unabridged Based on the Random House Dictionary, © Random House, Inc. 2009.

⁴ "document." *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. 06 Nov. 2009. <Dictionary.com http://dictionary.reference.com/browse/document>.

As such, because Kumar's transactions can be seen as data files (or, records of interaction), evidence (of financial interaction), or a non-executable file containing data for use by, in the case of Kumar, a banking application, Kumar's transactions can be seen as the same as the claimed "document".

ii) Examiner submits that a category can be seen as a folder. Firstly, in light of Appellant's own specification, a folder can be seen as the same as a category. For example, Appellant's disclosure, paragraph 0013 with emphasis, states "...associating the financial information with a *folder*, *category*, or group in the first system. *The folder is one of a plurality of folders, categories, or group* being associated with each other in a hierarchical manner". Thus, in light of this portion, a folder is synonymous with category. Therefore, Kumar's category(ies) can be seen as the claimed folder(s).

Next, Appellant states that "unlike a folder, a user cannot collapse or expand a list of transactions included in a category, and Kumar nowhere indicates that a category actually contains a group of transactions" (Brief, page 13, last paragraph). Examiner respectfully disagrees because in Kumar, figure 13, a user is able to display transactions categorized to associated accounts (see also Kumar, col. 32 lines 50-56; therein an account is a category of transactions). Thus, by a user selecting an account (drawing reference 247), the associated transactions are displayed (drawing reference 249). In other words, when the account (or category) is selected an expanded list of transactions is displayed. Furthermore, because the selected account (i.e. category) includes the transactions displayed, the account (i.e. category) is seen as a folder.

Rejection of claims 10-12, and 14 under 35 U.S.C. 103(a) (p. 14 of the Brief)

Argument (1): Fallon fails to provide any teaching whatsoever related to “a hierarchy of folders defined by the customer user in the online environment hosted at the host computer” as recited in Claim 10.

On page 16 of the Brief, Appellant argues that Fallon fails to provide any teaching whatsoever related to “a hierarchy of folders defined by the customer user in the online environment hosted at the host computer.” Examiner respectfully disagrees given the following:

Firstly, Fallon is seen to provide an on-line storage space to store a personal legacy plan (e.g. Fallon, abstract), and further the legacy plan is organized as folders (Fallon paragraph 0028; “the information may be stored in legal, medical, financial, and personal folders”). Further, Fallon teaches the personal legacy plan is stored at a secure central site (e.g. paragraph 0009; “the invention (3) stores the informational items on a secure server) removed from the user’s own location (paragraph 0028). Thus, with these teachings, Fallon teaches a hierarchy⁵ of folders in an online environment hosted at a host computer.

Furthermore, the Examiner submits that the hierarchy of folders is defined by the customer user. In one interpretation, the hierarchy of folders (seen in figure 3-1) is customized by the customer user in that the hierarchy (or folders within the legacy plan) is *named* by the user. In the example of Fallon, the user creates the folders under their name (e.g. “John and

⁵ Examiner submits that a user’s personal legacy plan may be seen as a hierarchy of folders in that the folders preferable contain information organized in a hierarchical fashion, Fallon, 0213). Furthermore, the folders themselves may contain subfolders (Fallon, 0169 “certain information is indexed across folders...for example a Legal Folder (and subfolders thereof).

Mary Smith). Thus, by the customer user naming the hierarchy, the user defines the hierarchy under their name. Nonetheless, the personal legacy plan in Fallon is *developed* by the user (0028) and therefore also teaches the hierarchy of folders is defined by the user. Further, in another interpretation, the user defines the hierarchy of folders by deciding to include information in their storage space. Thus, by including selected documents in the legacy plan (i.e. hierarchy of folders) the user builds and thus defines the hierarchy of folders⁶.

Argument (2): Fallon fails to provide any teaching whatsoever related to a “host computer...configured to provide a search across folders” as recited in Claim 10.

Appellant argues on page 17 of the Brief that Fallon fails to provide any teaching whatsoever related to a “host computer...configured to provide a search across folders”. Examiner respectfully disagrees given the following:

Appellant reproduces the cited paragraphs [0183]-[0184] and states that Fallon does not even mention the term “search”. While Examiner agrees that “search” is not found in these paragraphs, these paragraphs *do* recite a database structure including a plurality of tables (as highlighted by Appellant). Further in these paragraphs, Fallon explicitly recites the utilization of SQL (Structured Query Language) to *define, access, and manipulate* the data in the tables. In other words, Fallon allows a user to use a well known retrieval language to access (i.e. search) the information in their legacy plan (i.e. the legacy plan including at least personal, financial,

⁶ Although not directly relied upon for claim 10, Fallon in combination with Shutt (see rejection to claim 1) teaches the creation, thus definition of a folder. See Shutt, drawing reference 107, figure 12.

legal and medical folders). Thus, with the provision of SQL, a user is able to search across the folders in their legacy plan.

Furthermore, it is noted that Fallon also teaches elsewhere, the claimed search functionality by directly addressing the need to allow a user to store and *find documents related to personal legacy planning* (Fallon, 0007). Fallon also teaches in response to user input, returning user specified data retrieved from databases accessed by the server (0039, Fallon). Therein, Fallon again teaches the argued search functionality.

On page 18-19 of the Brief, Appellant essentially reiterates the same arguments applied to claims 1-3 and 6-9. Accordingly, these arguments have been addressed as seen in the above paragraphs in relation to these claims.

Thus, in light of the above, Appellant's arguments are respectfully found unpersuasive and therefore the applied references are maintained to render the claims unpatentable.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/ROBERT TIMBLIN/

Examiner, Art Unit 2167

Conferees:

/John R. Cottingham/

Supervisory Patent Examiner, Art Unit 2167

/Etienne P LeRoux/

Primary Examiner, Art Unit 2161